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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,819	11/18/1999	WARREN F. SCHMALENBERGER	SCHC,002	6427

7590 09/20/2007
Mark R. Wisner
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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09/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/442,819

Applicant(s)

SCHMALENBERGER, WARREN F.

Examiner

Daniel S. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Receipt of the RCE filed August 31, 2007 is acknowledged. Claims 1-32 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Reilly suggests that countries have developed composite series which reflect the performance of *all* securities, and that world capital markets are becoming *integrated—leading* to world capital indexes (see Reilly, “*Composite Security Market Series*”). It would have therefore been obvious for an artisan of ordinary skill in the art to integrate the *stock index* of Merrill Lynch into the Solomon Brother’s index and/or the *money market index* of Salomon Brothers into Merrill Lynch because one of ordinary skill in the art would have been familiar with the notoriously old and well known concept of “*diversification*” and thus have recognized the importance of diversification to provide a more integrated and comprehensive measure of the performance of capital markets of a country and/or various other countries. Thus the integration

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of various indexes would have been an obvious expedient well within the ordinary skill of the art. Thus the rejections are maintained herein, below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of in view of Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly, F.K., "Investment Analysis and Portfolio Management", 3rd Ed. The Dryden Press, Copyright 1989, pp. 165-170.

--Re claims, 1-21 and 24-27, Reilly anticipates the inventive concept of the applicant's invention by providing a comprehensive list of combined market sector indexes. In particular, Reilly discloses "*Salomon Brothers International Bond and Money Market and Performance Indexes*" which provides a comprehensive measure of the total return of high quality securities in mayor international sectors of the bond and money markets that is market-value weighted (see Reilly, page 165).

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--Reilly also discloses the "*Merrill Lynch-Willshire Capital Market Index*" which is a *market value-weighted index* that was created to measure the total return performance of the combined stock and bond indexes (see Reilly page 165).

--Commenting on the importance of "diversity," Reilly suggests that countries have developed composite series which reflect the performance of *all* securities, and that world capital markets are becoming *integrated—leading* to world capital indexes (see Reilly, "*Composite Security Market Series*"). It would have therefore been obvious for an artisan of ordinary skill in the art to integrate the *stock index* of Merrill Lynch into the Solomon Brother's index and/or the *money market index* of Salomon Brothers into Merrill Lynch because one of ordinary skill in the art would have been familiar with the notoriously old and well known concept of "*diversification*" and thus have recognized the importance of diversification to provide a more integrated and comprehensive measure of the performance of capital markets of a country and/or various other countries. Thus the integration of various indexes would have been an obvious expedient well within the ordinary skill of the art.

Furthermore, an artisan of ordinary skill in the art would be familiar with the concept of a "balanced fund" or "asset allocation fund" which characteristically invests its assets into money markets, bonds, preferred stock and common stock with the intention to provide both growth and income. Thus, since it is known in the art to provide indexes based upon various fund types, a balanced fund index (e.g. *Lipper Balanced Fund Index*) would be an obvious expedient well within the ordinary skill in the art.

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Re claims 22 and 23: Reilly fails to disclose, as in claims 22 and 23, that the indexes are calculated via a computer and encoded in the memory of a computer. However computers are widely used making business calculations and thus OFFICIAL NOTICE is taken for using computers for creating indexes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer, can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "Daniel S. Felten", with a stylized flourish at the end.

Daniel S Felten

Examiner

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DSF

9/11/2007